

REMARKS

By the present Amendment, minor revisions have been made in the specification, claim 1 has been amended to define one aspect of the present invention with greater precision, the term "type" has been removed from the claims without altering the substance thereof and claim 4 has been canceled without prejudice or disclaimer.

Before discussing the merits of the present application, applicant notes that the Examiner has included independent method claim 10 in each of the rejections set forth in the Official Action. Claim 10 was previously considered part of Group II in the restriction requirement set forth in the Official Action dated June 29, 2005, and the subject matter of this Group was not elected. If claim 10 has been inadvertently included in the rejections, then applicant respectfully requests the Examiner to withdraw the rejection of claim 10 and to state that no substantive examination of this claim has been made. On the other hand, if the Examiner purposely included claim 10 in the rejections, then the Examiner is respectfully requested to formally withdraw the restriction requirement and to examine dependent method claims 11-18 with the independent method claim 10. If the Examiner maintains the restriction requirement, applicant again reserves the right to request rejoinder pursuant to the provisions of MPEP §804.21(b) or to pursue the non-elected subject matter in a divisional application.

Turning to the rejections set forth in the Action, the Examiner has first raised a rejection under the second paragraph of 35 U.S.C. §112 relating to the alleged inconsistency between the recited linear-type alkyleneoxide adduct or branched-type alkyleneoxide adduct. The Examiner has further questioned the term "type" used for these adducts.

Taking these points in reverse order, applicant has met the Examiner's concern over the term "type" by removing the term throughout the claims. As to the other point, applicant believes that the Examiner's §112 rejection is based on an inadvertent misunderstanding of one aspect of the invention. In particular, whether a linear alkyleneoxide adduct or branched alkyleneoxide adduct is present is not determined by whether moiety A or B is present. The pendant methyl group in B does not itself create a branched alkyleneoxide adduct. This understanding is rendered clear by the discussion beginning at page 9, line 23 of the specification where it is stated that the branched compound has at least two groups represented by formula (II) and this recitation has now been incorporated into claim 1. Making this understanding even more clear are the illustrative compounds represented by formulas (III), (IV) and (IV') on pages 11 and 12 and the specific branched alkyleneoxide compounds A to H on pages 72 to 73. It will be noted from several of these compounds that they are considered "branched" even though they do not contain the B moiety with the pendant methyl group. Consistent with this understanding, the illustrative linear alkyleneoxide adducts a to v on pages 74-75 are considered "linear" even though they include the B moiety with the pendant methyl group. Accordingly, applicant respectfully submits that the claims of record fully comply with the provisions of the second paragraph of 35 U.S.C. §112, particularly when read in light of the specification, as one must do.

With a proper understanding of the present invention, those of ordinary skill in the art will appreciate that the claimed alkaline developing solution requires the presence of at least one linear alkyleneoxide adduct and at least one branched alkyleneoxide adduct. By having both adducts present in the developing solution, processing can be started immediately and can be stably conducted over an

extended period. Such substantial advantages are demonstrated in the Examples provided in the specification and can be contrasted against the Comparative Examples. More specifically, Tables 1 and 2 on pages 76 and 77 provide an array of illustrative developing solutions which contain one of branched alkyleneoxide adducts A-H and one of linear alkyleneoxide adducts a-v, as well as comparative developing solutions ((61)-(66)) which omit one or both of the branched and linear adducts. As can be understood from the results set forth in Tables 3-10, the illustrative developing solutions can provide immediate developing with good results and can sustain the results over an extended period and can be contrasted with the inferior results obtained with the comparative developing solutions.

Sasayama et al., U.S. Patent No. 6,364,544, does not disclose or suggest the presently claimed invention. The patent relates to an automatic developing apparatus and associated method. In the passage in columns 5 and 6 relied on by the Examiner in the Action, various surfactants are described. However, there is no teaching of using a linear alkyleneoxide adduct and a branched alkyleneoxide adduct as recited in the claims. In this respect, the Examiner's reference to polyoxyethylene, polyoxypropylene and polyoxybutylene in the Action is again based on a misunderstanding of what the claims recite which has now been rendered more clear by the amendments to the claims. Furthermore, there is absolutely no recognition in the patent of the advantageous results which the present invention can provide that have been amply demonstrated in the specification. Indeed, there is no mention that the disclosed surfactants have any effect on being able to start processing immediately or being able to conduct development on a stable basis over an extended period. Therefore, Sasayama et al. cannot be used in any way to reject the claims now of record.


With regard to the Examiner's reference to U.S. Patent No. 6,919,166, in section 5 of the Action, applicant agrees that the patent is not available as "prior art", but the reference should have been to 102(a) and not 102(b) (which relates to statutory bar prior art).

As a final matter, applicant notes that the acknowledged citation sheet from the Information Disclosure Statement filed on November 30, 2004, does not include the Examiner's initials next to U.S. Patent No. 5,670,294 and applicant requests acknowledgement of this document in the next Official Action.

Should the Examiner have any questions concerning the subject application, the Examiner is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

BUCHANAN INGERSOLL PC
(INCLUDING ATTORNEYS FROM BURNS, DOANE, SWECKER & MATHIS)

By: 
Robert G. Mukai
Registration No. 28,531

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-662

Date: January 18, 2006